



FEB 12 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Brian W. Poor  
Townsend and Townsend and Crew  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111

In re Application of SU	:	
U.S. Application No.: 10/009,508	:	
Int. Application No.: PCT/US99/08079	:	DECISION ON PETITION
Int. Filing Date: 13 April 1999	:	
Priority Date: none	:	UNDER 37 CFR 1.137(b)
Attorney Docket No.: 020093-001000US	:	
For: METHODS FOR THE DIAGNOSIS AND	:	
TREATMENT OF METASTATIC	:	
PROSTATE TUMORS	:	

This is in response to applicant's "Petition to Revive Unintentionally Abandoned Application" filed 06 November 2001.

### **BACKGROUND**

On 13 April 1999, applicant filed international application PCT/US99/08079. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 November 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 October 2001 (13 October 2001 was a Saturday).

International application PCT/US99/08079 became abandoned as to the United States at midnight on 15 October 2001 for failure to pay the basic national fee.

On 06 November 2001, applicant filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that "the entire delay, including the delay from the due date for the reply through the date of this Petition was unintentional."

### **DISCUSSION**

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless

previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), the petition states, "The entire delay, including the delay from the due date for the reply through the date of this Petition was unintentional." This statement is interpreted as a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be submitted.



Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

Telephone: 703-308-6614  
Facsimile: 703-308-6459